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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,216	03/29/2004	Luke Aram	1671-0295	3037
28078 7590 06/06/2007 MAGINOT, MOORE & BECK, LLP CHASE TOWER 111 MONUMENT CIRCLE SUITE 3250 INDIANAPOLIS, IN 46204			EXAMINER SAN MIGUEL, ANITZA M	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 06/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/812,216

Applicant(s)

ARAM ET AL.

Examiner

Anitza M. San Miguel

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/19/2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I (claims 1-21 and 30-36) in the reply filed on February 23, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without traverse** (MPEP § 818.03(a)).

Claims 22-29 have been canceled in amendment filed February 23, 2007.

Newly submitted claims 37-44 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the method can be practiced with another apparatus such as a manual saw or without the need of alignment guides (i.e. pins).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 37-44 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by Hitt (Reference U.S. Patent "5,077,902").

Hitt discloses a wire saw (24); a saw driver including a shaft (23a), a body (8) coupled at a first end to the shaft to be rotated, the body including a second end formed to include teeth, the wall being formed to include a driver surface (col. 2, lines 38-68 and col. 3, lines 53-61).

With regards to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Hitt (i.e. "adapted to be driven by a rotary drill to rotate about an axis"), which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3733

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mains et al. (Reference U.S. Patent "4,421,112", cited on IDS) in view of Suddaby (Reference Pub. No.: US 2004/0143280 A1).

Mains et al. (herein Mains) discloses a guide system comprising: a first and second alignment pin (12); and wherein the first and the second alignment pin (12) are configured and oriented to define a resection of reference (col. 2, lines 8-38). The first and second alignment pin (12) has a length sufficient that the first and second alignment pin (12) extends completely through the bone with one tip extending beyond the bone on the first side and the second tip extending beyond the bone on the opposite side (col. 4, lines 27-33). The resection surface of reference is a plane (col. 4, lines 57-68). The apparatus further comprises a guide block formed to include a first and second guide hole (col. 2, lines 51-54). The first and second guide hole being sized to receive a drill sized to form a hole in the sized to receive the first and second alignment pin. The second guide hole oriented with respect to the first guide hole to define a plane (col. 2, lines 54-67). The guide block is formed to include a first and a second guide saw guide. The first alignment pin (12) is received in the bone and the first guide hole and the second alignment pin (12) is received in the bone and the second guide hole (col. 5, lines 4-34). The guide block is formed to include a third guide hole extending through

the block, sized to receive a drill sized to form a hole, and a third alignment pin (col. 3, lines 35-44). The apparatus further comprises a saw driver (col. 5, lines 48-49)

Mains disclose the claimed invention except for the wire saw. Suddaby teaches to provide a cutting wire (wire saw; paragraphs 0010, 0014, and 0030) having sufficient tensile strength when drawn into a small diameter in order to transect a carpal ligament. It is noted that the cutting wire disclosed by Suddaby has a uniform circular cross-section, or it may be formed with serrations, corrugations or other irregularities to improve its cutting action. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Mains having a wire saw, in view of Suddaby, in order to transect a bone. It is noted that the wire saw disclosed by Suddaby is capable of being used to transect a bone.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mains et al (Reference U.S. Patent "4,421,112", as cited in IDS).

Mains et al. discloses the claimed invention except for the first and second alignment pins and the wire saw being configured to be inserted through incisions less than six centimeters long; less than about two centimeters long; and about one centimeter long. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Mains with the first and second alignment pins configured to be inserted through incisions less than six centimeters long, less than about two centimeters long and about one centimeter long, since it has been held that where the general conditions of a claim are disclosed in the prior art,

discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-21 and 30-36 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

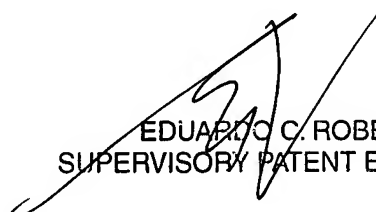
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anitza M. San Miguel whose telephone number is 571-272-3279. The examiner can normally be reached on 8:00 am - 5:30 pm EST (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASM



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER